

REMARKS

Applicant has studied the Office Action of 18 March 2003 and offers the following remarks. Before addressing the rejections, Applicant provides a brief summary of the present invention to provide context for the remainder of the remarks.

The present invention is directed to facilitating instant messaging for a telephony user. It is expected that the telephony user will be communicating with a computer user, but such is not strictly required. The telephony user issues an audible command. The audible command includes a message meaning and one or more message characteristics. An example is provided in paragraph 35 of the specification. This audible command is then sent to the audio server (also called an audio browser), which in turn converts the audible command to a text command. The text command is sent to the IM proxy server for creation of an instant message based on the meaning and the characteristics. Specifically, the IM proxy server takes the meaning and modifies it according to the provided characteristics. The IM proxy server then forwards the just-created instant message to the IM server, and the IM server routes the instant message to the intended recipient.

The IM proxy server communicates with the telephony user according to a call dialog that the IM proxy server creates. Details about the call dialog may be found in paragraphs 44 and 45 of the specification. The call dialog controls how audio is delivered to the mobile terminal and how messages are delivered to the IM proxy server.

Initially, claims 1-25 and 28 were rejected under 35 U.S.C. § 112 as containing subject matter which was not described in the specification. Regarding claims 1, 13, and 25, the Patent Office opines that the limitation "receiving a command derived from an audio command, the command including a message meaning with a message characteristic" is not supported. Applicant respectfully traverses. As explained above in the summary, the audible command is converted by the audio server into a text command. Specifically, paragraph 35 of the specification states "The audio browser 29 will receive corresponding audio and convert the audio to text." The audio in question is the preceding sentence's audible command, so the conversion of the audio to text creates a text command. This is not spelled out explicitly in the specification, but is readily apparent to one of ordinary skill in the art upon a thorough reading of the specification. With respect to the claims, the recited "command" corresponds to the "text command," and is clearly derived from the audio command. Applicant is not required to mimic

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slavishly the language of the specification when crafting claims. MPEP § 608.01(o). One of ordinary skill in the art can readily equate the specification's "audible command" to the claims' "audio command" and the specification's "text command" with the claims' generic "command." In light of this explanation, Applicant requests withdrawal of the § 112 rejection at this time because the subject matter of the claims is clearly supported and described in the specification.

The Patent Office further opined that the phrase "changing an appearance of the content" of claim 28 is not disclosed in the specification. Applicant respectfully traverses. Applicant discloses changing the color of the instant message at paragraph 37. Changing the color corresponds to changing an appearance of the content. Thus, the phrase is fully supported by the specification. Applicant requests withdrawal of this § 112 rejection at this time.

Claims 1, 4-11, 13, 16-23, 25, and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. in view of Dutta et al. Claims 2, 3, 14, and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. in view of Dutta et al. and in view of Horvitz et al. Claims 12 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. in view of Dutta et al. and in view of Hodges et al. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element recited in the claim is present within the combination of references. MPEP § 2143.03.

Applicant herein amends claims 1, 13, and 25 to recite the creation of the call dialog and that the receiving of the command takes place according to the call dialog. As noted above, the call dialog is explained in paragraphs 44 and 45 of the specification. New claim 29 is added to recite how the commands are passed back and forth between the IM proxy server and the audio server. As the previous response canceled two claims (26 and 27) and added one (28), the addition of a second new claim (29) should not necessitate a new fee.

The rejections under 35 U.S.C. § 103 rely primarily upon Dowens et al. in view of Dutta et al. Applicant has carefully read these two references and finds no teaching or suggestion within the references either singly, or in combination, that the reception is done according to the recited call dialog. Indeed, both references contain little in the way of enabling disclosures as to how the translation takes place and/or how the communication with the telephony user is handled. As such, the references of record for claims 1, 13, and 25 do not teach or suggest the recited claim element, and the Patent Office has not established *prima facie* obviousness with

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respect to the claim element. To this extent, claims 1, 13, and 25 are not rendered obvious by Dowens et al. in view of Dutta et al., and are patentable over the rejection of record.

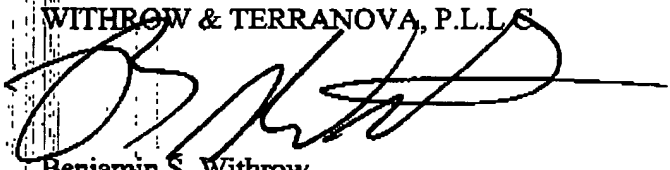
The secondary rejections that rely on Horvitz et al. and Hodges et al. do nothing to cure the deficiency of the underlying combination. Applicant has read the secondary references and finds nothing in the references that teaches or suggests the recited call dialog. Thus, the claims that depend from the amended independent claims also define over the combinations of record because these combinations do not teach or suggest a claim element.

Applicant requests reconsideration of the rejections in light of the amendments presented herein. Applicant respectfully opines that after such a reconsideration, it will be readily apparent that the rejections of record do not render the claims obvious, and the claims are in a condition for allowance. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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